# UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/751,811 | 12/29/2000 | Robert E. Gleichauf | 062891.0462 | 8466 |

| | | |
|---|---|---|
| 5073      7590      05/23/2007 | | |
| BAKER BOTTS L.L.P.<br>2001 ROSS AVENUE<br>SUITE 600<br>DALLAS, TX 75201-2980 | | |

| EXAMINER |
|---|
| MOORTHY, ARAVIND K |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2131 | |

| NOTIFICATION DATE | DELIVERY MODE |
|---|---|
| 05/23/2007 | ELECTRONIC |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mike.furr@bakerbotts.com
ptomail1@bakerbotts.com

PTOL-90A (Rev. 04/07)

| | Office Action Summary | Application No. 09/751,811 | Applicant(s) GLEICHAUF, ROBERT E. |
|---|---|---|---|
| | | Examiner Aravind K. Moorthy | Art Unit 2131 |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1) ☒ Responsive to communication(s) filed on <u>28 March 2007</u>.

2a) ☐ This action is **FINAL**.  2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) <u>1-39</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-39</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

## Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>29 December 2000</u> is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All  b) ☐ Some * c) ☐ None of:

        1. ☐ Certified copies of the priority documents have been received.

        2. ☐ Certified copies of the priority documents have been received in Application No. _____.

        3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

## DETAILED ACTION

1. This is in response to the arguments filed on 13 March 2007.

2. Claims 1-39 are pending in the application.

3. Claims 1-39 have been rejected.

### *Response to Arguments*

4. Applicant's arguments with respect to claims 1-39 have been considered but are moot in view

of the new ground(s) of rejection.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**5. Claims 1-6, 12, 14, 16-20, 22, 27, 29-31, 36 and 37 are rejected under 35 U.S.C. 102(e) as**

**being anticipated by Chan U.S. Patent No. 6,760,759 B1.**

As to claims 1, 29 and 36, Chan discloses a method for real-time insertion of services

during a telephony call session over a communication network, comprising:

- initiating a service request message by a first client to a first server, the

service request message initiated after a telephony call session has been

established [column 5 line 64 to column 6 line 24] between the first client and a

communication network the service request message including the first client

identity and a requested service available from a second server comprising a plurality of services [column 4, lines 32-58];

    - determining that the first client is authorized to use the requested service at the first server [column 5 line 64 to column 6 line 24];

    - and delivering the requested service to the first client during the established telephony call session by the second server in response to determining that the first client is authorized to use the requested service [column 5 line 64 to column 6 line 24].

As to claims 2 and 17, Chan discloses that at least one of the services comprises an application operable to provide text viewing and modification capabilities [column 3 line 57 to column 4 line 15].

As to claims 3 and 18, Chan discloses that at least one of the services comprises an application operable to provide graphic viewing and modification capabilities [column 3 line 57 to column 4 line 15].

As to claims 4 and 19, Chan discloses that the requested service is only available during the telephony call session [column 5 line 64 to column 6 line 24].

As to claims 5, 20 and 30, Chan discloses the method further comprising:

    - comparing the first client identity and the requested service with a list stored in the first server, the list comprising a plurality of clients authorized to use at least one of the services available from the second server [column 5 line 64 to column 6 line 24];

- and issuing a ticket to the first client if the list includes authorization for

the first client to use the requested service [column 5 line 64 to column 6 line 24].

As to claims 6, 31 and 37, Chan discloses the method further comprising:

- comparing the first client identity and the requested service with a list

stored in the first server, the list comprising a plurality of clients authorized to use

at least one of the services available from the second server [column 5 line 64 to

column 6 line 24];

- issuing a ticket to the first client in response to determining that the list

includes authorization for the first client to use the requested service, the ticket

including the first client identity and the requested service; sending the ticket to

the second server by the first client [column 6 line 41 to column 7 line 17];

- and reading the ticket at the second server to retrieve the requested

service [column 6 line 41 to column 7 line 17].

As to claims 12 and 27, Chan suggests pressing a button associated with the requested

service at the first client during a telephony call session to initiate the service request message

[column 6 line 41 to column 7 line 17].

As to claim 14, Chan discloses a communication system, comprising:

- establish a telephony call session between the client and a

communication network [column 6 line 41 to column 7 line 17]; and

- initiate a service request message after the telephony call session has

been established, the service request message including a client identifier and a

requested service to be inserted into the telephony call session [column 6 line 41 to column 7 line 17];

- a first device operable to couple to the communication network, the first device comprising a list of clients authorized to use at least one of a plurality of services [column 6 line 41 to column 7 line 17];

- and a second device operable to couple to the communication network, the second device further operable to insert the requested service into the established telephony call session in response to determining that the list includes the client identifier and the requested service [column 6 line 41 to column 7 line 17].

As to claim 16, Chan discloses that the first device is operable to determine that the client is authorized to use the requested service [column 6 line 41 to column 7 line 17].

As to claim 22, Chan suggest that the communication system further comprises:

- a plurality of remote clients coupled to the communication network [column 4, lines 32-58];

- and a plurality of remote second devices coupled to the communication network, each remote second device associated with at least one of the remote clients [0089].

## *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

**6. Claims 7-11, 21, 23-26, 32-35, 38 and 39 arc rejected under 35 U.S.C. 103(a) as being**

**unpatentable over Chan U.S. Patent No. 6,760,759 B1 as applied to claims 1, 14, 29 and 36**

**above, and further in view of Bittinger et al U.S. Patent No. 6,760,759 B1.**

As to claims 7, 8, 10, 11, 21, 23-26, 32, 33, 35, 38 and 39, Chan discloses comparing the

first client identity and the requested service with a list stored in the first server. Chan teaches

that the list comprises a plurality of clients authorized to use at least one of the services available

from the second server.

Chan does not teach issuing a ticket to the first client in response to determining that the

list includes authorization for the first client to use the requested service. Chan does not teach

that the ticket includes the first client identity and the requested service. Chan does not teach

sending the ticket and an address associated with a second client to the second server by the first

client. Chan does not teach reading the ticket at the second server to retrieve the requested

service for a second client. Chan does not teach delivering the requested service to the second

client based on the address received from the first client.

Bittinger et al teaches sending the ticket and an address associated with a second client to

the second server by the first client. Bittinger et al teaches reading the ticket at the second server

to retrieve the requested service for a second client. Bittinger et al teaches delivering the

requested service to the second client based on the address received from the first client [column 7, lines 1-49].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Chan so that the ticket sent from the first client to the second server included the address associated with a second client. The second server would have read the ticket and retrieved the requested service. The service would have been delivered to the second client based on address received from the first client.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Chan by the teaching of Bittinger et al because by moving a server-side registry to a computer hosting a client application (i.e., a "client-side" registry), a server application can notify a client application when server application startup processing is complete and can provide a server stub associated with the server application to the client application. As a result, a client application can be automatically notified that a server application is ready to receive client application requests. Consequently, the need for server polling may be eliminated [column 3 line 65 to column 4 line 7].

As to claims 9 and 34, Chan teaches comparing the first client identity and the requested service with a list stored in the first server. Chan teaches that the list comprises a plurality of clients authorized to use at least one of the services available from the second server [column 5 line 64 to column 6 line 24]. Chan teaches issuing a ticket to the second server in response to determining that the list includes authorization for the first client to use the requested service [column 5 line 64 to column 6 line 24].

**7. Claims 13 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chan U.S. Patent No. 6,760,759 B1 as applied to claims 1 and 14 above, and further in view of Lancaster et al U.S. Patent No. 5,854,894.**

As to claims13 and 28, Chan does not teach selecting the requested service from a menu displayed on the first client during the telephony call session to initiate the service request message.

Lancaster et al teaches selecting a requested service from a menu displayed on the frst client during a telephony call session to initiate the service request message [column 2, lines 12-18].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Chan so that client selected the desired service from a service menu display to initiate the service request message.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Chan by the teaching of Lancaster et al because a menu provides a means for a client to know what ser<ices are available by a second server.

**8. Claim 15 is rejected under 35 U.S.C. 103(x) as being unpatentable over Chan U.S. Patent No. 6,760,759 B1 as applied to claim 14 above, and further in view of Berbec et al U.S. Patent No. 6,122,631.**

As to claim 15, Chan does not teach that the client further comprises a cache operable to store a requested service and the requested service removable from the cache when the telephony call session terminates.

Berbec et al teaches a client that comprises a cache operable to store a requested service and the requested service removable from the cache when the telephony call session terminates [column 5, lines 19-27].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Chan so that client would have stored the requested service in cache and would have removed the requested service from cache when the telephony call session terminated.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Chan by the teaching of Berbec et al because this allows the client to access files dynamically and allow the server to distribute files in a secure manner [column 1, lines 47-61].

## *Conclusion*

9.      Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aravind K. Moorthy whose telephone number is 571-272-3793. The examiner can normally be reached on Monday-Friday, 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R. Sheikh can be reached on 571-272-3795.  The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system.  Status information for published applications may be obtained from either Private PAIR or Public PAIR.  Status information for unpublished applications is available through Private PAIR only.  For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Aravind K Moorthy
May 17, 2007

AYAZ SHEIKH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100